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PTOL-90A (Rev. 04/07)

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/799,860
Filing Date: March 12, 2004
Appellant(s): PRAKASH, VIPUL V.

Dag Johansen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/15/2008 appealing from the Office action mailed 4/15/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,654,787   Aronson et al.   11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 5, 10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "a length of the electronic communication" in claims 1, 5, 10 and 15 is a relative term which renders the claim indefinite. The term "a length" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. One of ordinary skill in the art is able to read this term multiple ways, and it is unclear what Applicant intends by this term. A length of the electronic communication can be construed as a string of data present within the communication, or a length of the

electronic communication can be construed as dealing with the overall size of the body of the electronic communication. This presents two separate bodies of art that can be viewed when comparing the prior art to the claims to determine patentability. One of ordinary skill in the art necessarily needs to know what Applicant intends by "a length of the electronic communication."

Claims 1-4 and 6-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Aronson et al. (US 6,654,787 B1).

In regard to claim 1, Aronson disclosed:

extracting URLs from electronic communication; and column 5, lines 50-67

analyzing the URLs extracted to determine whether the electronic communication is of a first predetermined category, said analyzing comprising. Column 5, lines 50-67

generating one or more signatures using a length of the electronic communication and the URLs extracted. column 5, lines 50-67

In regard to claim 2, Aronson disclosed:

extracting the URLs comprises extracting at least one of a hostname, a domain name, a subsection of a domain relative link, and an Internet Protocol (IP) address from the electronic communication. Column 5, lines 59-64

In regard to claims 3, 18, Aronson disclosed:

performing a predetermined operation on the electronic communication if the electronic communication is determined to be of the first predetermined category. Column 4, lines 35-67

In regard to claim 4, Aronson disclosed:

selecting one or more of the one or more signatures generated; and column 5, lines 50-67

comparing the selected signatures against a plurality of predetermined signatures generated from a plurality of known electronic communications of the first predetermined category. Column 5, lines 50-67; column 6, lines 1-29

In regard to claim 6, Aronson disclosed:

using the extracted URLs as the one or more signatures. Column 5, lines 50-67

In regard to claim 7, Aronson disclosed:

generating the one or more signatures based on at least one of a protocol, a hostname, a domain name, a subsection of a domain relative link, and an Internet Protocol (IP) address from the electronic communication. Column 5, lines 50-67

In regard to claim 8, Aronson disclosed:

classifying the electronic communication to be of the first predetermined category if one of the selected signatures matches one of the plurality of predetermined signatures. Column 5, lines 50-67; column 6, lines 1-20

In regard to claim 9, Aronson disclosed:

the plurality of predetermined signatures is derived from a plurality of electronic documents reported via a collaborative submission mechanism. Column 5, lines 9-20

In regard to claim 10, Aronson disclosed:

generating one or more signatures of electronic communication based on URLs in the electronic communication; and column 5, lines 50-67

determining whether the electronic communication is of a first predetermined category using the one or more signatures generated. Column 5, lines 50-67

In regard to claim 11, Aronson disclosed:

selecting one or more of the one or more signatures generated based on a plurality of predetermined criteria; column 5, lines 50-67

comparing the selected signatures against a plurality of predetermined signatures; and column 5, lines 50-67; column 6, lines 1-29

classifying the electronic communication to be of the first predetermined category if one

of the selected signatures matches one of the plurality of predetermined signatures. Column 5,

lines 50-67; column 6, lines 1-29

In regard to claim 12, Aronson disclosed:

selecting a signature if the signature represents a domain that was registered within a

predetermined period of time. Column 5, lines 50-67

In regard to claim 13, Aronson disclosed:

selecting signatures representing one or more of a protocol, a hostname, a domain

name, and a subsection of a domain relative link having a predetermined string of letters.

Column 5, lines 50-67; column 6, lines 44-62

In regard to claim 14, Aronson disclosed:

extracting the URLs from the electronic communication. Column 5, lines 50-67

In regard to claim 15, Aronson disclosed:

a plurality of databases to store a plurality of predetermined signatures of a plurality of

known electronic communications of a first predetermined category; and column 3, lines 1-9;

column 4, lines 45-67; column 5, lines 9-20;

     a server, coupled to the plurality of databases, including:

          a memory device to store a plurality of instructions; column 2, lines 61-67 *and*

          a processor, coupled to the memory device, to retrieve the plurality of instructions

     from the memory device and to perform operations in response to the plurality of

     operations, the operations comprising: column 2, lines 61-67

          extracting URLs from electronic communication to generate one or more

          signatures; and column 5, lines 50-67

          comparing one or more of the one or more signatures generated against

          the plurality of predetermined signatures stored in the plurality of databases to

          determine whether the electronic communication is of the first predetermined

          category. Column 5, lines 50-67; column 6, lines 1-29

In regard to claim 16, Aronson disclosed:

> *the URLs comprises at least one of a hostname, a domain name, a subsection of a domain relative link, and an Internet Protocol (IP) address.* Column 5, lines 50-67

In regard to claim 17, Aronson disclosed:

> *selecting one or more of the one or more signatures generated based on a plurality of predetermined criteria.* Column 5, lines 50-67

In regard to claim 19, Aronson disclosed:

> *a database, coupled to the server, to store a plurality of reports from which the plurality of predetermined signatures are generated.* Column 4, lines 45-67; column 5, lines 20-67; column 6, lines 1-29

In regard to claim 20, Aronson disclosed:

> *the plurality of databases are in a remote location from the server.* Column 3, lines 1-9

(10) Response to Argument

Applicant's entire argument revolves around the broadest reasonable interpretation of the term "length".

Applicant presented evidence of the Merriam-Webster Online Dictionary, which provided six definitions of the term "length". Applicant admits that the definition the examiner used is definition five of the dictionary Applicant admitted as evidence, and that definition five is a proper definition for the term "length". Applicant appears to take the position that only the first three definitions of the term "length" in the dictionary entry cited meet the "plain meaning" of the word "length", and that any other definition in the dictionary is not part of the "plain meaning", contrary to the lexicographers at the Merriam-Webster company.

Applicant argues that Aronson fails to disclose *generating one or more signatures using a length of the electronic communication and the URLs extracted.* Column 5, line 64 clearly shows the use of URLs extracted. Phone numbers and addresses are also used, which are both *a length of the electronic communication*. Applicant did not limit the length in the claim to a size, and Applicant did not compute a

length allowing the reading to be limited to a numerical length. An address is a "length" or string in the electronic communication.

Applicant attempts to disavow the non-limiting words of how a length "may be" computed. Without going into arguments over the meaning of the word "compute", Applicant specifically stated that a length is not limited to a numerical function by stating that the length may be computed. Applicant never limited the length in the specification to a numerical value, and the Office pointed this out with an appropriate rejection under 35 U.S.C. 112, second paragraph, because the term was indefinite and could lead to multiple claim interpretations.

The Office pointed out potential allowable subject matter to the Applicant within the specification in the final office action. **It is recommended that Applicant incorporate specification, page 7, paragraph 0021's formula for computing a length into the independent claims.**

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jeffrey R. Swearingen/

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